

REMARKS

Re. the Office Action

Claims 1-23 were examined. On the basis of this examination,

- (i) Claims 1-18, and 22-23 are allowed
- (ii) Claim 19 is rejected under 35 U.S.C. 102 (e) as being anticipated by U.S. Patent No. 6,413,254 ("Hissong") in that Hissong provides an ultrasonic ablation device to reduce/remove tissue internal to the tongue without penetrating the mucosal surface of the tongue.

[The Office Action cites rejection of Claim 18 under this heading, however in view of Item (i) above, it is believed that this rejection refers to Claim 19].

- (iii) Claim 19 is rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 5,879,349 ("Edwards '349") in view of U.S. Patent no. 5,823,197 ("Edwards '197") and U.S. Patent No. 5,800,429 ("Edwards '429").

In rejecting the claims under this heading, the Office Action states that although Edwards '349 teaches piercing the tongue and ablating tissue therein, it does not teach debulking the tongue without penetrating the mucosal layer.

However, according the Office Action, Edwards '429 teaches ablation of interior of the nasal tissue using RF energy, and Edwards '429 teaches the same procedure using non-penetrating energy delivery.

Thus, according to the Office Action, Claim 19 is unpatentable because it would haven been obvious to provide Edwards '349 device with a non-penetrating means because Edwards '197 and Edwards '429 show the obvious use of either penetrating needles, or non-penetrating energy means.

- (iv) Claims 20-21 are objected to but would be allowable if rewritten in independent form

- (v) The specification is objected to because the status of cross-referenced applications should be updated as appropriate

- (vi) The Information Statement filed October 6, 2003 is in the file, but was not considered because it failed to comply with 37 CFR 1.98(a)(2) in that it failed to provide a

legible copy of each cited foreign patent, each non-patent literature, or other information that caused it to be listed. Also, some documents listed in the IDS did not appear on form PTO-1440.

In this reply, the Applicants submit herewith the IDS for consideration.

In view of amendment to the specification, the claims, and the following remarks, reconsideration and the allowance of the application is respectfully requested.

AMENDMENTS

Re. The objection to the Specification

The specification at page 2 is amended to update cross-referenced applications. Withdrawal of the rejection and reconsideration of the claims are respectfully requested

Re. The rejection of Claim 19 under Items (ii) and (iii), above

Claims 19 is amended to specify that the method includes advancing a probe into the cavity, said probe comprising an active electrode; and applying a high frequency voltage potential difference across the active electrode and a return electrode to debulk tissue, without breaching the mucosal surface. Support for this amendment can be found, for example, at page 8, paragraph [0019].

Thus as amended, Claim 19 is not taught by Hissong because Hissong does not teach a method that involves using a high frequency voltage across electrodes to debulk the tongue.

Similarly, none of the cited “Edwards ‘349”, Edwards ‘197” and Edwards ‘429 references teach or suggest using a high frequency voltage across electrodes to debulk the tongue without breaching the mucosal tissue.

Accordingly, since the Applicant’s method is neither taught nor suggested by any combination of the cited reference, withdrawal of the rejections and reconsideration of the claims are respectfully requested.

Re. The objection to Claims 20-21

In view of the present amendments and remarks, the Applicants respectfully request postponement of complying amendments to Claims 20-21 until the Claim 19 is reconsidered.

Re. The allowance of Claims 1-18 and 22-23

The Applicants acknowledge with thanks the allowance Claims 1-18 and 22-23.

SUMMARY

It is believed that all the claims are in consideration for allowance. Accordingly, in view of the present amendments, claims, and IDS, reconsideration and allowance is respectfully requested. If an issue remains the can be resolved by a telephone conference, please contact the undersigned at telephone (408) 735-6486.

Sincerely,



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